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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,091	11/03/2003	Donald E. Weder	8404.014	9586
30589	7590	11/01/2004	EXAMINER	
DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY, OK 73113			PALO, FRANCIS T	
			ART UNIT	PAPER NUMBER

3644

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/700,091

Applicant(s)

WEDER, DONALD E.

Examiner

Francis T. Palo

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/3/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the following informalities:

Paragraph [0001] should be updated to reflect the Patent status of 10/337,582.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-12** are rejected under 35 U.S.C. 102(b)

as being anticipated by Weder (US 5,861,199) 1999.

Art Unit: 3644

Regarding **independent claim-1**:

Weder discloses in the '199 Abstract, a method for making decorative grass, comprising slitting a sheet of material into strips and further chopping the strips into segments to provide the decorative grass (read as the "cutting" step as cited in the instant claim).

Weder further discloses a number of embodiments comprising the use of one or more sheets of material laminated together, as cited in the preamble ("laminations").

Weder further discloses the first sheet of material may be constructed of a single layer of material or a plurality of layers of the same or different types of materials, and that the layers may be laminated or connected together by any method known in the art (column-8, beginning at line-11).

Weder specifically discloses a layer of polymeric film as cited in the instant claim, but does not specifically recite a cloth layer as cited in the instant claim.

As mentioned above, Weder does disclose layers of the same or different types of materials, and the Examiner has given a reasonable interpretation consistent with the broad teaching of "different types of materials", to include a layer of cloth. Furthermore, Weder '199 discloses synthetic polymer film as a preference, and an accepted definition of synthetic film is polyester, which would read on some of the cloth selections cited in the instant claim.

Art Unit: 3644

Regarding **independent claim-7**:

Claim-7 cites a laminate construction consisting of two layers of polymeric film and a layer of cloth there between.

Weder '199 discloses the use of one or more sheets of a material and the same or different types of materials, as discussed above in the rejection of independent claim-1.

The aforementioned discussion above is also therefore applicable to the instant claim-7.

Regarding **claims 2 and 8**:

Weder discloses material thickness ranges beginning in column-8, which overlap the cited ranges in the claims.

Regarding **claims 3 and 9**:

Weder discloses cellophane and polypropylene as a preference material (column-8, lines 42 and 48).

Regarding **claims 4 and 10**:

Weder discloses tinted or colored bonding material (column-11, lines 15-19).

Regarding **claims 5 and 11**:

Weder discloses embossing and/or printing (column-7, lines 20-21).

Art Unit: 3644

Regarding claims **6 and 12**:

Weder discloses the slitting and cutting steps as cited, in the '199 Abstract.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-12** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,672,004.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant independent claims 1 and 7 are merely a rewording of the conflicting independent claims 1 and 5 respectively.

Instant dependent claims 2 and 8 are identical to conflicting claim-2,

Instant dependent claims 3 and 9 are identical to conflicting claim-3,

Instant dependent claims 4 and 10 are identical to conflicting claim-4,

Art Unit: 3644

Instant dependent claims 5 and 11 are encompassed by claims 1 and 5,

Instant dependent claims 6 and 12 are encompassed by claims 1 and 5.

***Terminal Disclaimer***

The terminal disclaimer filed on 11/3/03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,554,620 has been reviewed and is accepted.

The terminal disclaimer has been recorded.

Please note however the nonstatutory double patenting rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 703-305-5595. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 703-305-7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Francis T. Palo*

Francis T. Palo  
Examiner  
Art Unit 3644